



06-16-03

DAE  
#34

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: US Patent Application 09/068,278  
Filed July 9, 1998  
Art Unit 3722  
Examiner Erica D. Ergenbright  
Telephone (703) 308-6395  
Fax (703) 308-3579  
Applicant: Locher et al.  
Attorney Docket: (R) S11-PC/PC1/US

Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Petition to Revive for Unavoidable Abandonment

Dear Examiner Ergenbright:

Applicant's attorney called to conduct a telephone discussion with the Examiner regarding the Office Action issued by the Examiner on November 22, 2002. Applicant's attorney learned that the Examiner was on maternity leave, and proceeded to discuss this case with the Examiner's supervisor, Ms. Andrea Wellington. Ms. Wellington acknowledged acceptance of receipt of Applicant's argument for why the Swiss application is a priority document in this case (which was faxed to the Examiner on March 7, 2003, in response to the Office Action of November 22, 2002). Ms. Wellington also stated that there was still an outstanding issue to be dealt with in this case (claim rejections citing the patents to Wollermann and Koch). Applicant agreed that a response would be submitted regarding those claim rejections.

Following the discussion with Ms. Wellington, Applicant's attorney received a faxed communication (copy included herewith) from the USPTO. The communication included:

06/17/2003 ANDUNDAF1 00000095 09068278

01 FC:2452

55.00 UP

(R) S11-US Locher  
09/068,278

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JUN 17 2003

OFFICE OF PETITIONS

**NOTICE OF APPEAL FROM THE PRIMARY EXAMINER TO  
THE BOARD OF PATENT APPEALS AND INTERFERENCES (Small Entity)**

Docket No.  
( R ) S-11 US

In Re Application Of:

Locher

Serial No.

09/068,278

Filing Date

July 9, 1998

Examiner

Ergenbright

Group Art Unit

3722

Invention:

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Applicant(s) hereby appeal(s) to the Board of Patent Appeals and Interferences from the decision of the Primary Examiner dated November 22, 2002 finally rejecting Claim(s) 39-130

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for this Notice of Appeal is: \$160.00

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is
- ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. A duplicate copy of this sheet is enclosed.

*M. Robert Kestenbaum*

Signature

Dated: June 13, 2003

M. Robert Kestenbaum  
Reg. No. 20,430  
11011 Bermuda Dunes NE  
Albuquerque, NM 87111  
(505) 323-0771  
Fax: (505) 323-0865  
Mailed by Express Mail on June 13, 2003

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**OFFICE OF PETITIONS**

I certify that this document and fee is being deposited on \_\_\_\_\_ with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

05/17/2003 AWD:DAF1 00000095 09068278

02 00:2401

160.00 DP

CC:

- A cover sheet, on which a mailing date of March 13, 2003 is stated (this cover sheet is marked "A" in this package of documents accompanying this Petition to Revive for Unavoidable Abandonment). The Examiner noted in the cover sheet was "Cadugan, Erica E". Had the cover sheet specified Ms. Wellington, it would have been clear that the cover sheet applied only to the Advisory Action from Ms. Wellington, and not the Office Action copy that was sent. It was this cover sheet that caused Applicant's attorney to believe that the date stated on the cover sheet (March 13, 2003) applied to the entire faxed communication, and the date for responding to the outstanding Office Action had been restarted.
- A copy of the entire fax received (Marked "B"), including:
  - The Office Action mailed November 22, 2002.
  - The Interview Summary noting that the response period was still running for the outstanding response to the rejection on prior art.

Given the inclusion of the cover sheet with the mailing date of March 13, 2003, Applicant's attorney reasonably believed that the response period for the Office Action mailed November 22, 2002 had been re-started to March 13, 2003. Applicant's attorney reasonably believed that the time still running stated in the Interview Summary related to the beginning date of March 13, 2003, rather than the beginning date of the originally mailed Office Action. Thus, Applicant reasonably believed that the response to the communication was due June 13, 2003, and had not yet occurred.

To substantiate that this was Applicant's attorney's belief, copies of his docket sheet, calendar, and letter to the client, which notes the response period had been re-started are included herewith. (Marked "C").

Applicant's attorney did not learn that the response period had not been restarted until the Examiner telephoned to notify him that the case had gone abandoned for failure to respond to the Office Action mailed November 22, 2002 (which ended on May 22, 2003). Therefore, the abandonment was unavoidable, because Applicant's attorney did not learn that the response period had not been restarted and the case was abandoned until it was too late to submit a timely response.

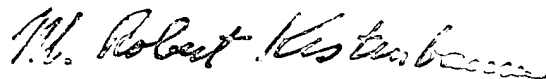
To further substantiate this was Applicant's attorney's belief, an amendment responding to the outstanding Office Action (which he believed was due on June 13, 2003), is included with this Petition, which is filed on June 13, 2003. The amendment was ready to be submitted when the Examiner notified Applicant's attorney the case had gone abandoned, but it was too late to submit the amendment by that time. The Petition and amendment are submitted now due to the time it took to prepare this petition and the supporting documentation for this submission.

Applicant's attorney discussed this abandonment with Ms. Wellington. Ms. Wellington suggested that a Petition to Revive for Unavoidable Abandonment be filed. She suggested that, together with the Petition to Revive for Unavoidable Abandonment, we submit the evidence included herewith supporting that Applicant's attorney did, indeed, believe the response period had been restarted, as well as the reasons that Applicant's attorney believed the response period was re-started, together with the response to the outstanding Office Action. Further, Ms. Wellington suggested that if the Petition to Revive for Unavoidable Abandonment was denied, she suggested that a request be made to waive the petition fee for a Petition to Revive for Unintentional Abandonment, given the circumstances.

Applicant's attorney hereby respectfully petitions that this application be revived pursuant to the enclosed Petition to Revive for Unavoidable Abandonment. PTO Form 2038 is included herewith authorizing charging a credit card for the \$55 petition fee.

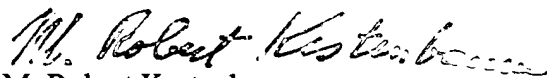
Applicant's attorney further respectfully requests that if this Petition to Revive for Unavoidable Abandonment is not granted, then the petition fee for a Petition to Revive for Unintentional Abandonment be waived, and a Petition to Revive for Unintentional Abandonment be granted.

Respectfully submitted,

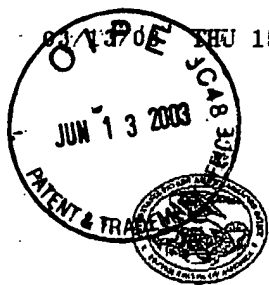


M. Robert Kestenbaum  
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11011 Bermuda Dunes NE  
Albuquerque, NM USA 87111  
Telephone (505) 323-0771  
Facsimile (505) 323-0865

I hereby certify this correspondence is being deposited with the US Postal Service Express Mail in an envelope with sufficient postage to Mail Stop Petition, PO Box 1450, Commissioner for Patents, Alexandria, VA 22313-1450 on June 13, 2003, Express Mail Label #EU964783945US.



M. Robert Kestenbaum



THU 15:32 FAX 703 3087957

US PATENT OFFICE

025

(A)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,278	07/09/1998	BEAT LOCHER	ROSS11-PC/P	2154

7590 03/13/2003  
M ROBERT KESTENBAUM  
11011 BERMUDA DUNES NE  
ALBUQUERQUE, NM 87111

EXAMINER

CADUGAN, ERICA E

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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JUN 17 2003  
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(B)

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**Trudy Mitchell****United States Patent & Trademark Office  
Customer Service Center, Technology Center 3700****703-306-5648**

---

**Date: 3/13/03****Total # of pages including cover sheet 27****To: Laurie****Recipient Fax: (505-323-0865)****From: Trudy Mitchell****Customer Service Rep.****Customer Service Center****Sender Fax: 703 308-7957**

**Memo: Laurie, here is the copy of the office action that was requested, if there is anything else that is needed please feel free to call our Customer Service Center.**

**Thank you  
Trudy Mitchell  
Customer Service Center  
TC- 3700**

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**Fax•Fax•Fax•Fax•Fax•Fax•Fax•Fax•Fax•Fax•Fax•Fax****RECEIVED****JUN 17 2003****OFFICE OF PETITIONS**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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09/068,278	07/09/1998	BEAT LOCHER	ROSS11-PC/P	2154

7590 11/22/2002  
M ROBERT KESTENBAUM  
11011 BERMUDA DUNES NE  
ALBUQUERQUE, NM 87111

EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 11/22/2002

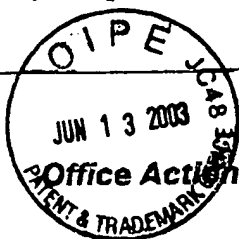
Please find below and/or attached an Office communication concerning this application or proceeding.

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Application No.

09/068,278

Applicant(s)

LOCHER ET AL

Examiner

Erica E Cadugan

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-130 is/are pending in the application.
- 4a) Of the above claim(s) 50-74, 83, 86, 91-99, 114, 119, 124 and 126-130 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-49, 75-82, 84, 85, 87-90, 100-113, 115-118, 120-123 and 125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 August 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.


## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 30.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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 <b>Interview Summary</b>	Application No. 09/068,278	Applicant(s) LOCHER ET AL.	
	Examiner Erica E Cadogan	Art Unit 3722	

All participants (applicant, applicant's representative, PTO personnel):

(1) Erica E Cadogan. (3) \_\_\_\_\_.

(2) Robert Kestenbaum. (4) \_\_\_\_\_.

Date of Interview: 19 November 2002.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal (copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: n/a.

Identification of prior art discussed: n/a.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

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Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

## Summary of Record of Interview Requirements

**Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record**

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation Sheet (PTO-413)

Application No. 09/068,278

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner contacted Mr. Kestenbaum regarding an earlier informal conversation about the case. In August, Mr. Kestenbaum contacted the Examiner to ask some general questions about the application, and stated to the Examiner that he was currently in the hospital undergoing medical treatment. Mr. Kestenbaum also stated that he was under medication and may not remember our conversation and thus may have to contact me again in the future with similar questions. Accordingly, because of Mr. Kestenbaum's medical treatment, Examiner did not treat the conversation as a formal conversation about the case. However, during the course of the August conversation, Mr. Kestenbaum mentioned a possible public use or sale of the invention if the application was not able to claim priority back to the Swiss application 3235/95, filed 11/6/95. At this time, the application is not being granted the 1995 priority date, nor does it appear that the present application will in the future be entitled to the 1995 priority date of the Swiss 3235/95 application. Thus, Examiner contacted Mr. Kestenbaum to remind him of the earlier (August) conversation regarding the possible public use or sale of the invention to give Mr. Kestenbaum the opportunity to verify whether or not any applicable public use or sale of the present invention occurred prior to the earliest granted priority date (currently September 23, 1996) that would affect the patentability of the presently-claimed invention. Mr. Kestenbaum said that he would look into the matter..

Application/Control Number: 09/068,278

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**DETAILED ACTION*****Faxing of Responses to Office Actions***

1. In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 872-9302. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

***Election/Restrictions***

2. For purposes of clarity, for the reasons set forth in the office action mailed February 27, 2001, claims 39-130 are pending in this application and of these, claims 50-74, 83, 86, 91-99, 114, 119, 124, and 126-130 are withdrawn from consideration.

***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. While it is recognized that Applicant stated, in the response submitted August 27, 2002, that "[A]pplicant will promptly submit a Declaration making the appropriate changes to this application, as necessary", until Applicant has done so, the present objection to the declaration still applies.

To restate the previously set forth explanation of why the oath or declaration is defective, the oath or declaration is defective because: it improperly claims benefit under 35 USC 120 (in the most recently filed declaration – in the older one it improperly claimed benefit of this

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application under 35 USC 119) of PCT/EP97/05216. Note that the present application was filed under 35 USC 371 as being the national stage application of PCT/EO97/05216, and that the notice of acceptance of the present application under 35 USC 371 (paper number 6) was mailed on July 14, 1999. Thus, the present application thus may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application. See MPEP §1893.03(c). In other words, it is improper for the present 371 application to claim priority to itself.

It is noted that Applicant stated (on page 22 of the response submitted 8/27/02) the following:

In numbered paragraph 12, the Examiner quotes Applicant's statement that the application was filed as a national stage application. Applicant's statement referred to the entry of this application into the National Stage under 35 USC 371. Thereafter, an RCE was filed on October 18, 2001. We respectfully request that the Examiner make note of this to correct any confusion on this point.

It appears that from these statements that Applicant may be asserting that by filing an RCE of the present National Stage application filed under 35 USC 371, the present application is no longer a National Stage application filed under 35 USC 371. However, this is not the case. See, for example, MPEP section 706.07(h), which states that an "RCE is in fact continued examination of the same application", filed under statutory authority from 35 USC 132(b), i.e., is not a "new" application filed under statutory authority from 35 USC 111(a), 120, or 121. Thus, the above explanation, previously provided, about the deficiencies of the declaration, has not changed.

A new declaration is required, as indicated above, correcting the above-noted deficiencies.

FILE A  
NEW DECLARATION  
CLAIM 6  
P. 47-49  
10479  
SWISS 3125

Application/Control Number: 09/068,278

Page 4

Art Unit: 3722

**Priority**

4. Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d) to PCT/EP96/04790. A request for the certified copy of this application has been made to WIPO. Acknowledgment is made of applicant's claim for priority under 35

U.S.C. 119(a)-(d) based upon an application No. 3235/95 filed in Switzerland on November 6, 1995. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the International Application of which the present application is the national stage (PCT/EP97/05216) was filed more than twelve months thereafter. See 35 U.S.C. 119(a)-

(d)), and particularly section 119(a) which states the following: (a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

In the instant case, the application in this country, i.e., PCT/EP97/05216, which is an international application designating the U.S., was filed on September 23, 1997, which is later than twelve months from the date of filing of the Swiss application no. 3235/95, filed November 6, 1995, and thus, PCT/EP97/05216 is not entitled under 35 USC 119 to the priority date of Swiss application no. 3235/95.

Additionally note that the claim for priority to the Swiss application No. 3235/95 was not made in the request of the International application of which the present application is the

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national stage. For purposes of clarity, the present application is a 371 of PCT/EP97/05216 (filing date of PCT is 9/23/1997), and additionally, a proper claim for priority under 35 USC 119 to the following applications has been made: Swiss Application 2329/36 (filing date 9/23/1996) and PCT/EP96/04790 (filing date 11/4/1996). *Drawings*

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "group of cable processing tools" consisting of at least one of "clamping tools, marking apparatuses and grinders" of claim 43 and the processing station comprising at least one transport or processing station, selected from the group consisting of "an insulation stripping station, a sawing station, a cutting station, a twisting station, a shaping station, a crimping station, a soldering station, a cable processing station, and a manipulator" of claim 101 must each be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

7. Note also that the Form PTO-948 (Notice of Draftsperson's Patent Drawing Review) that was an attachment to paper number 12 objected to the drawings because of the German captions, among other things.

8. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

9. Corrected or substitute drawings were submitted on August 27, 2002. Specifically, a proposed new Figure 33 was submitted to attempt to show the claimed features indicated in the office action mailed February 27, 2002 as not being shown. Applicant has cited a number of



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locations in the specification as originally filed for providing support for the newly-filed Figure.

However, none of these locations teach the level of detail shown in the proposed Figure 33.

However, note that claim 43 sets forth plural tool holders in a "lateral direction", (which lateral is "sideward" with respect to the transport path of the cable, per claim 39). Newly proposed Figure 33 does not show lateral plural toolholders holding at least two tools selected from the group of cable processing tools consisting of at least one of "clamping tools, marking tools, and grinders" as set forth in claim 43, but instead shows marking rollers 205, 206 (per the paragraph added to the specification, page 42, before the last paragraph, that describes Figure 33, in the response filed 8/27/2001) spaced longitudinally along the transport path from holders holding cutting knives, spaced longitudinally from grinders 208, 209 (per the paragraph added to the specification, page 42, before the last paragraph, that describes Figure 33, in the response filed 8/27/2001), and thus claim 43 does not provide support for newly-proposed Figure 33.

Regarding the assertion (p. 22 of the response filed August 27, 2002) with respect to original claim 14, original claim 14 depended from any of the preceding claims, including original claim 2, and original claim 2 depended from original claim 1. Original claim 1 set forth "at least one knife station", original claim 2 further set forth that "the knife station for receiving a plurality of tools is formed transversely with respect to the transport path so that each tool can be positioned in a working position along the transport path, at least two, optionally continuously positionable, holding apparatuses being provided for the tools, and the tools being selected from the group consisting of the cable-processing tools, for example, comprising: knives, crimping tools, twisting tools, punching tools, clamping apparatuses, marking apparatuses, grinding apparatuses, etc.", and original claim 14 further set forth "wherein a plurality of tool support feed

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means having a plurality of tool supports (1,2) are arranged along the axis". Note that nothing in these claims, nor in the specification as originally filed, provides the level of detail shown in newly-proposed Figure 33. For example, nothing in the specification as originally filed teaches the order of the marking, cutting, and grinding devices shown in new Figure 33, nothing teaches that the marker is a roller-type marker, nothing teaches that the grinder is a roller-type grinder. Additionally, these claims set forth "at least two, optionally continuously positionable holding apparatuses provided for the tools", e.g., markers, grinders, clamping apparatuses, etc., (see original claim 2). Note that Figure 2 does not show the marking and grinding devices in the originally-claimed manner, but rather shows rollers that are not held by any "holding apparatuses".

Therefore, newly-proposed Figure 33 constitutes new matter as the specification as originally filed did not provide support for the arrangement of tools set forth in this figure.

**Therefore, the proposed drawing correction submitted August 27, 2002, is not approved.**

10. Additionally, note that there are other types of stations set forth in claim 101 as described above that are not shown in proposed Figure 33, and thus proposed Figure 33 does not overcome the objection to the drawings as not showing details of all elements of the claimed invention.

### ***Specification***

11. The amendment filed August 27, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the new paragraph describing Figure 33. Note that the specification as originally filed does not provide support for the particular arrangement

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of tools set forth in this paragraph, as described in the above explanation about why Figure 33 is not approved.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 40, 75-82, 100-113, 115-116, and 125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 40, 75-82, 100-113, 115-116, and 125 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention. Examples of these instances are listed below, but these instances are not limited to the listed examples. Applicant is advised to closely review the indicated claims for other occurrences. It is noted that Applicant, on pages 20-21 of the response filed August 27, 2002, made a number of explanations to try to clarify many of the issues with respect to 35 USC 112, second paragraph that were pointed out by the examiner in the office action mailed February 27, 2002. However, it is noted that in many cases, Applicant did not amend the claims in question. For example, in the rejection of claim 40 under 35 USC 112, second paragraph, the Examiner stated that "it is unclear how the upper and lower positions of the tools "can be combined" as claimed", for which Applicant provided an explanation on page 20 of the aforementioned response. However, Applicant did not amend this claim. Thus, the rejection still applies, because it is unclear as set forth in the claim how or in what regard the "upper and lower positions" of the tools "can be combined".

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There are several positively recited limitations that lack sufficient antecedent bases in the claims. The following list of examples is not meant to be all-inclusive. Examples of these instances are: "said clamping and centering apparatus" in claim 77; "said processing station" in claim 79 (plural different ones previously set forth); "said clamping and centering jaws" in claim 77; "the rotatable blade" in claim 82 (previously at least one); "said clamping and centering apparatus" (previously "at least one") in claim 113; "said transport path" in claim 115, etc. Applicant is required to review the indicated claims for further similar instances.

In claim 82, it appears that in line 2, "and" should be changed to --or-- to be consistent with the alternative "or" provided in claim 75. Otherwise, it is unclear how many rotatable blades applicant is intending to set forth, as claim 75 only provides one rotatable blade via the alternative "or" in line 3.

As set forth in claim 100, it is unclear as claimed in what regard a "path", i.e., a location, is "coordinated" with a "processing station". As a side note, it is noted that the structure of claim 100 is not tied or related in any way via any claim language to the structure set forth in claim 88.

In claim 107, it is unclear via the use of the indefinite article "a" as claimed whether "a tool support" is intended to be a subset of the "at least one tool support" previously set forth (in claim 88).

In claim 40, it is unclear how the upper and lower positions of the tools "can be combined" as claimed.

In claims 75 and 108, it is unclear as claimed whether "the first processing station" (cl. 75, "the processing station" in cl. 108) comprises (in one alternative) "a second processing station", or whether the "apparatus" comprises either of a "first" (cl. 75, "a processing station" in

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cl. 108) or a "second" processing station. Also in claim 75, it is unclear from "at least one transport path" what the path is a transport of, i.e., for transporting what?

In claim 107, as amended, the scope of the claim is unclear because it is unclear as claimed what actuators are encompassed by the limitation of "a motor-controlled actuator (101) known per se", i.e., it is unclear exactly what constitutes a "known per se" motor-controlled actuator. Examiner suggests deleting "known per se" from this claim.

In claim 125, it is unclear as claimed in what regard the action of opening and closing the belts is "cable-shape dependent".

***Claim Rejections - 35 USC § 102***

14. Claims 88, 39-45, 89, 90, 84, 117, and 123, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Patent No. 09-046844 (Tomoji).

15. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a certified translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

16. Tomoji discloses the claimed invention comprising: a pair of tool supports (not numbered, but attached to the bottoms of supporting bodies 4, 4'), at least two tools 7 in pairs 7A-7D (see Figure 2), and a tool support feed 3 above a first transport path (not numbered but coincident with 8), along which a cable/wire 8 is inserted in a feed direction, wherein the tool support feed 3 is formed for a controlled lateral drive along moving rails 5, 5' (see Figure 2 and abstract, lines 4-5 of the "Solution" section) for controlled sideward movement of the tool supports. Note that rails 5, 5' are perpendicular to the vertical (as viewed in Figure 2) working direction of the tools. Also note, with respect to claim 88, that the lateral positioning of the tool

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support can be controlled to any number of desired positions along rails 5, 5'. With respect to claims 90 and 40, Tomoji also discloses separate tool support feeds 3, 3' coordinated with each of the tool supports (see Figure 2 and abstract, line 5 of the "Solution" section that teaches selective movement). With respect to claim 41, the tool supports are both ultimately connected to the part shown in Figure 2 as element 2, and "can" be displaced together with this common support part. With respect to claim 42, note that the pairs of tools (first pair 7B, 7D; second pair 7A, 7C as shown in Figure 2) are arranged laterally with respect to the wire feed direction, and that the tools or knives 7A-7D are cable processing tools (see entire Abstract). With respect to claim 43, it is noted that blades are cutting tools. With respect to claim 89, the tool supports are "adjustable" toward and away from the path of the wire 8 both vertically (as viewed in Figure 2) and horizontally (as viewed in Figure 2) along rails 5, 5'. With respect to claims 84 and 117, as best understood, applicant is claiming that at least one from the list of (1) upper and lower roller, (2) continuous belts of a pair of rollers, (3) a pair of continuous belts, and (4) upper and lower tool holders, has each of the plurality of items (i.e., if item (1) is met, both the upper and the lower roller) displaceable as claimed. Tomoji teaches that both the upper and lower tool holders are displaceable transversely with respect to the transport path as described above (i.e., both vertically and horizontally as viewed in Figure 2). Note that if the upper tool holder was moved to the right (as viewed in Figure 2) along rail 5 and the lower tool holder was moved to the left (as viewed in Figure 2) along rail 5', a cable lying in between the tool holders could be twisted. With respect to claim 123, the tools 7A-7D, the supports, and the positioners are all within one "module" as viewed in Figure 2.

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17. Claims 88, 39, 41-49, 75-79, 81, 84, 85, 89, 100-113, 115-118, and 121-123, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,879,926 (Wollermann et al.). Wollermann et al. teaches a wire insulation stripping apparatus (shown in Figure 1 as a whole) having programmable strippers 12 at workstations WS (see Figure 1 and column 9) for stripping the ends of wire segments 18 that are continuously fed via conveyor mechanism 11 (see Figure 1). Each workstation WS (there are two such workstations shown in Figure 1) has a turret 76 (Figures 1, 2, 7, 8). Each turret 76 has an upper sector 77B and a lower sector 77A (see Figures 2 and 10 specifically). Each of these sectors has a plurality of insulation cutting means such as 101A and 101B including knives such as 91A and 91B arranged in pairs (Figures 10, 7, and 2, and column 11, lines 27-44 and column 12, lines 1-19). The upper and lower sectors 77B and 77A constitute "tool supports". The turret 76 is rotated about the axis of shaft 43 by a drive means 90 that includes a step motor 92 (Figures 3 and 7 and column 11, lines 57-60). Note that control of the various drives taught by Wollermann are effected by a CPU (column 9, lines 20-24), and that a sensor is employed in conjunction with the CPU to signal a home position when a wire to be stripped is in position (column 16, lines 33-42). Also note that as the turret 76 is rotated, the tool supports 77A and B will be moved in a direction that is perpendicular to the working direction of the tools (as the tool working direction extends into the paper as viewed in Figure 1 and the direction of movement of the tool supports 77A and B is in the plane of the paper as viewed in Figure 1). Note that the embodiment shown in Figures 7 and 8 has six mounting portions 87, each of which can have a pair of blades mounted thereto, and that thus the supports can be controlled to at least six different positions. With respect to claim 39, note that the feed direction of the wire or cable 18 is vertically as

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shown in Figure 1, and that the bisecting centerline of each wire or cable 18 (would be vertical as shown in Figure 1) defines a "first transport path" as the wire or cable 18 is fed via the conveyor 11. With respect to claim 41, the upper and lower tool supports 77B and 77A are both mounted on shaft 43 for rotational movement therewith (column 11, lines 3-6 and 46-47). With respect to claim 44, the tool supports 77B and 77A have mounted thereon slide members 106B and 106A (Figures 10 and 4) which in turn have mounted thereon the blades 91B and 91A (Figures 4 and 10 and column 15, lines 11-12). Actuation of transducers 171A and 171B actuates the slide members 106B and 106A of the tool supports toward and away from one another, which is also toward and away from the first transport path (Figure 4 and column 15, lines 11-20). With respect to claim 46, note that the cable or wire 18 is fed between pairs of blades 91B and 91A (Figures 2-5). With respect to claims 75 and 108, note that the blades are mounted to a rotating turret 76 as described above, and that the axis of rotation of the turret extends along shaft 43 which is "along", i.e., beside or at hand to, the first transport path as set forth above. With respect to claims 76 and 109, the cable or wire 18 is held via gripping and guiding means 141 while being incised with the blades 91A, 91B (column 16, line 56 through column 17, line 1). As viewed in Figure 4, the gripping and guiding means 141 utilizes upper and lower gripping jaws 152 and 151 to grip the wire 18 on two sides thereof. As the gripping and guiding means 141 is guiding the wire to a desired position and then holding it there (note "gripping" and "guiding" means), it inherently holds the wire 18 in a "centered" manner. Also note that the gripping jaws 152 and 151 are in the immediate vicinity of the blades 91A and 91B (see Figure 4). With respect to claim 110, the blade and clamping drives are "coupled" via common control by the CPU. With respect to claim 111, as best understood, the clamping and blade drives are



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"separated" in that they do not function simultaneously (columns 16-17). With respect to claims 112 and 113, note that while the gripping jaws are holding the wire 18, they do not rotate. With respect to claim 77, note that a vertical plane that is in the plane of the paper as viewed in Figure 4 could intersect or contain both of the gripping jaws 152 and 151 such that they would "lie" in a plane, and that each jaw has a retaining surface (not labeled, but shown as approximately horizontal in Figure 4). Note that it is "possible" to close the jaws 152 and 151 to approximately zero cable diameter by pivoting them about pivot shafts 157 and 156 until the jaws meet (see Figure 4). With respect to claim 78, note that the gripping and guiding means 141 has a slide frame 142 that reciprocates in the direction of arrows 198 and 199 (see Figures 6 and 11 and column 14, lines 12-19), and that the gripping and guiding means 141 comprises set screws 158 and 159 that function as stops to vary the open spacing between the gripper jaws 152 and 151 (column 14, lines 29-37). Specifically regarding claim 79, the workstations WS include the blade turret 76 and the gripping and guiding means 141. The workstations WS each constitute "automatic processing modules", and are "removably" mounted on the cable processing machine (shown as a whole in Figure 1), in that the workstations can or are "able" to be removed via removing machine bolts 26 (see column 9, lines 45-58 and Figures 2-4). Specifically regarding claim 81, jaws 152 and 151 are part of arms 149 and 148 which are shown in Figure 4 as "L-shaped", and the jaws 152 and 151 each have a serrated gripping portion (column 14, lines 39-41) that covers a "substantial" axial range of a cable sheath and ends that project directly adjacent to the knives 91A and 91B (see Figure 4). With respect to claims 84 and 117, as best understood, applicant is claiming that at least one from the list of (1) upper and lower roller, (2) continuous belts of a pair of rollers, (3) a pair of continuous belts, and (4) upper and lower tool

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holders, has each of the plurality of items (i.e., if item (1) is met, both the upper and the lower roller) displaceable as claimed. Wollermann teaches that the slide members 106B and 106A (described above) are mounted on tool supports 77B and 77A for movement toward and away from one another, which is also toward and away from the first transport path (Figure 4 and column 15, lines 11-20). With respect to claims 85 and 118, note that the arms 148 and 149 can be "swiveled" downwardly and upwardly about pivot shafts 156 and 157. With respect to claim 100, note that the conveyor mechanism 11 is composed of two spaced apart conveyor units 16 and 17, one of which is stationary and one of which is laterally adjustable (column 9, lines 31-37) via movable carriage 31 (column 10, lines 43-55). As described above, the bisecting centerline of the wires 18 (would be vertical as viewed in Figure 1) describes a transport path. If the carriage 31 is moved in the direction of arrows 74A and 74B (Figure 7, column 10, lines 43-55, which is to the left or right as viewed in Figure 1), a different bisecting centerline would be defined, and thus a different transport path would be defined. With respect to the further processing station, as described above, there are plural stripper 12 workstations WS, and additionally, there are also terminal applying stations 19 (Figure 1 and column 9, lines 32-44) which could constitute any of the "shaping station", the "crimping station", or the "cable processing station" set forth in claim 101. With respect to claim 102, the carriage 31 is mounted in linear guideways 23 (column 9, lines 55-58) transversely to the transport paths as described above, and "can be" moved via a drive apparatus including step motor 58 (column 10, lines 43-52). Specifically regarding claim 103, as previously described, conveyor units 16 and 17 serve to transport the cable or wire 18, and could be considered with respect to this particular claim to be "transporters", and as viewed in Figure 1, the conveyors 16 and 17 each extend vertically

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beyond the top and bottom (constituting the "both sides" claimed) of each of the stripping 12 stations WS. With respect to claims 104 and 105, the CPU controls all of the drives in prearranged sequences (column 9, lines 20-24). With respect to claim 107, note that the claim is not a method claim, and that Wollermann teaches the claimed apparatus structure of a transporter (the carriage 31 in this instance) that is connected to the blade station WS by the step motor 58 that positions both the carriage 31 and the stripping device (i.e., the turret 76 and the gripping and guiding means 141) as the stripping device is attached to the carriage (column 10, lines 43-64). Note that the adjustment of carriage 31 could result in a "diametrically opposite" transverse "adjustment" of the stripping station WS as they can be moved relative to one another (column 10, lines 63-64). With respect to claim 115, note for example that the carriage 31 (which could be considered a transporter) has ultimately mounted thereon the knives 91A and 91B which are movable "symmetrically with respect to the transport path as described above. With respect to claim 106, note that the two conveyors 16 and 17 are also controlled by the CPU.

***Claim Rejections - 35 USC § 103***

18. Claims 87, 120, and 125, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,879,926 (Wollermann et al.) as applied to claims 88 and 39 above, and further in view of U.S. Patent No. 5,109,598 (Koch). Wollermann et al. teaches all aspects of the invention as claimed in claims 87, 120, and 125 as described in the above rejection based thereon, but does not teach that the cable drives 16 and 17 are belt drives. Koch teaches a driving system for clamping and driving a cable 18 utilizing a stationary belt drive 1 (Figures 1 and 2, column 4, lines 12-15) and a displaceable belt drive 2 (Figures 1 and 2 and column 4, lines 22-25). Koch's belt drives are coordinated with the cable-working (in this case, a stripper and

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terminal applicator) device (column 6, lines 4-25). In the cable driving devices 16 and 17 taught by Wollermann, very little detail is provided. Note that in Figure 4 of Wollermann, it appears that the wire or cable 18 is passed through an oversized bore in conveyor 17 so as to be conveyed thereby. This system, while allowing a variety of wire diameters to be used, does not provide for firm gripping of the wire 18 by the conveyor 17, which could lead to manufacturing error. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted each of the conveyors 16 and 17 taught by Wollermann et al. with first and second belt drives (for a total of four belt drives) as taught by Koch and to have coordinated the movement of these belt drives with the CPU taught by Wollermann et al. for the purpose of increasing manufacturing accuracy by providing that the transported wires are positively clamped by the conveyors.

***Allowable Subject Matter***

19. Claims 80 and 82, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

20. Applicant's arguments submitted August 27, 2002 have been fully considered but they are not persuasive.

21. It appears that Applicant's arguments with respect to any prior art rejection appear to be based on Applicant's assertions that Applicant is entitled to the priority date of Swiss application 3235/95 filed November 6, 1995. However, this is not persuasive. Firstly, Applicant is not entitled to the priority of the Swiss application 3235/95 for the reasons described above.

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Additionally, with respect to the Tomoji reference (Japanese Patent Document 09046844), note that the publication date of the Tomoji reference is February 14, 1997, and thus, the Tomoji reference is prior art under 35 USC 102(a) because Applicant has not provided a certified translation of the priority documents being relied upon to overcome the Tomoji reference (specifically, of the Swiss 2329/36 application filed 9/23/1996).

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22. Additionally, note that the other art rejections pending in the case are based on art that would not be overcome even with the 1995 date of the Swiss application. For example, note that U.S. Pat. No. 4,879,926 (Wollermann et al.) was published in 1989.

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23. Also, with respect to Applicant's assertions regarding "the enclosed WO publication sheet 98/13907, with inter-line translation", it is noted firstly, that the copy of this document provided by Applicant does not match the copy of this document provided to the USPTO by WIPO and thus the document supplied by Applicant cannot be relied upon by the Examiner for making any determinations. Secondly, it is noted that, even for the sake of argument, if the document supplied by applicant was able to be relied upon, note that for the detailed reasons set forth above, Applicant is still not entitled to the 1995 filing date of the Swiss application 3235/95.

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### Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadogan whose telephone number is (703) 308-6395. The examiner can normally be reached on M-F, 7:30 a.m. to 5:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cec

November 19, 2002



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,278	07/09/1998	BEAT LOCHER	ROSS11-PC/P	2154

7590 03/13/2003  
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EXAMINER

CADUGAN, ERICA E

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Interview Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/068,278		LOCHER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	A. L. Wellington		3722	

All participants (applicant, applicant's representative, PTO personnel):

(1) A. L. Wellington.

(3) \_\_\_\_\_

(2) Robert Kestenbaum.

(4) \_\_\_\_\_

Date of Interview: 12 March 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal (copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: n/a.

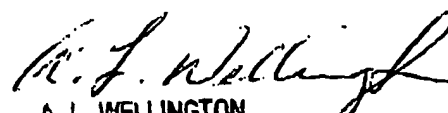
Identification of prior art discussed: Wolermann '926 and Koch '598.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Verified receipt of priority claim argument of Swiss Application 3235 (paper # 30). Informed applicant that there are outstanding rejections and issues that were not addressed nor overcome by the priority of the Swiss document therefore the paper received will be entered as a miscellaneous paper and applicant's time for response to the Final Rejection mailed on 11/22/02 is still running.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
 A. L. WELLINGTON  
 SUPERVISORY PATENT EXAMINER  
 TECHNOLOGY CENTER 3700

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required



## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.



C

**M. Robert Kestenbaum, LLC**  
**Patent and Trademark Matters**

11011 Bermuda Dunes NE ♦ Albuquerque, New Mexico 87111-6556 ♦ USA  
Phone (505) 323-0771 ♦ Fax (505) 323-0865 ♦ Email: lkestenbaum@comcast.net

21 March 2003

Paul Rosenich  
Patentbüro  
Paul Rosenich AG  
BGZ  
FL-9497 Triesenberg  
Liechtenstein

Re: Your File S11-PC/PC1/US  
US Patent Application 09/068,278  
Locher

Dear Paul:

I am faxing you an Office Action mailed 13 March 2003. The Examiner's supervisor has re-started the response date for the Office Action that was mailed on 22 November 2002.

It was written by the Examiner's boss, the Supervisory Patent Examiner, Mrs. Wellington.

Mrs. Wellington points out that we must respond to the rejection under 35 USC 102 on Wollerman and rejection under 35 USC 103 on Wollerman and Koch.

Please review the Office Action so that we can discuss it, and provide me with your instructions.

I think we are making progress!

Our response is due 13 June 2003.

With Best Regards,

M. Robert Kestenbaum

**RECEIVED**

JUN 17 2003

**OFFICE OF PETITIONS**

# PUMPKIN FOLDER ACTION ITEM CHECK LIST

Mailed 2002	Docket #	Inventor	Action	Comments	IR?	Due Date	Done ?
2/4/02	(1) 54124	Parajewski	AAFA	+NCA		2 OCT 02	
—	—	—	—	DD		2 JAN 03	28 Dec 02
8/13/02	(1) 6891.7	Kawiec	AAFA	+NCA	1/1/12	13 NOV	13 Dec
—	—	—	—	NCA DD -	Due -	13 FEB	
9/11/02	(2) A99059	Shyfer	AAFA	+NCA	1/1/29	11 DEC	11 Feb
—	—	—	—	NCA DD		11 MAR	
24 Sept	(1) 503.8	HAHN	Appeal Brief	(FIX)		24 OCT	
—	—	—	—	—	DD	24 March 03	
24 Sept	C99074PJS	Shofa	AAFA	+ <del>DD</del>		24 Dec	
—	—	—	ALLOWED	File NCA		24 Mar	
23 OCT	(2) 97057	Volck	AAFA	+NCA		23 JAN	
—	—	—	—	DD		23 APR	25 4/23/03
9 Nov	(1) 53005	ZWIGLE	AAFA	+NCA ✓		8 FEB	
—	—	—	—	DD		9 MAY	May 8
8 Nov	53898	Fischer	AAFA			8 Feb 03	3/23/03
—	—	—	—	+NCA DD		8 May 03	5/8/03
14 Nov 02	(m) 1-US	Jagutzki	AAFA			14 Feb 03	3/23/03
—	—	—	—	+NCA DD		14 May 03	
21 Nov	(1) 4967	Reiterbach	AAFA			21 Feb	
—	—	—	—	+NCA DD		21 May	
22 Nov	(1) 51115	Locher	AAFA			22 Feb	13 June 03
—	—	—	—	+NCA DD		22 MAY	13 Sept 03

Note: Date rechecked with new OA date of 3/13/03

# May 19-25

## 2003

Week 21

April 2003							May 2003						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
		1	2	3	4	5					1	2	3
6	7	8	9	10	11	12	4	5	6	7	8	9	10
13	14	15	16	17	18	19	11	12	13	14	15	16	17
20	21	22	23	24	25	26	18	19	20	21	22	23	24
27	28	29	30				25	26	27	28	29	30	31

Monday, May 19

Don't Forget

Victoria Day (Canada)  
139/226

7 ~~Schmidt~~ ~~posting~~ (M) ~~01R00002~~ ~~DD~~ ~~DA~~ 11/19/02 ~~Submitter~~ 4/21/03 3

8 4

9 5

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Tuesday, May 20

Don't Forget

140/225

7 3

8 Rudin (H) 970 M 14/2/03 AAF A DD 6/18/03 4

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Wednesday, May 21

Don't Forget

141/224

7 Letterhead (B) BUP-4907- ~~AAFA~~ ~~FUCA~~ ~~DD~~ ~~DA~~ 11/21/02 - ~~Allard~~ 3

8 File non if not allowed by 5/21/03 4

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Thursday, May 22

Don't Forget

142/223

7 ~~Large~~ (D) ~~SIFUS~~ ~~AAFA~~ ~~FUCA~~ ~~DD~~ ~~DA~~ 11/22/02 ~~GO~~ ~~NEW~~ ~~DA~~ - Disregard the 3

8 4

9 (NOTE ENTRY - HIGHLIGHTED FOR EMPHASIS) 5

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July 2003							August 2003						
S	M	T	W	T	F	S	S	M	T	W	T	F	S
6	7	8	9	10	11	12	3	4	5	6	7	8	9
13	14	15	16	17	18	19	10	11	12	13	14	15	16
20	21	22	23	24	25	26	17	18	19	20	21	22	23
27	28	29	30	31			24	25	26	27	28	29	30
							31						

# June 9-15

## 2003

Week 24

My To Do

Family To Do

Other Matters

Friday, Jun. 13

Don't Forget

164/201

7	(L) 98048 PUS Schustee AAFA OA 3/13/03	3
8		4
9		5
10	(R) S-11 US Locher AAFA (Date Restricted) New OA Date 3/13/03	6
11		7
12	(NOTE ENTRY - HIGHLIGHTED FOR EMPHASIS)	8
1		9
2		10

Saturday, Jun. 14

Don't Forget

Flag Day  
165/200

7		3
8	(H) 01W10327 USP Harwath-Seyfried Amendment OA 3/14/03	4
9		5
10	(H) 03B0P0039 USP Britson NTFMP-English special Inv Dec OA 4/14/03	6
11		7
12	(R) 11-US Friberg Election OA 5/14/03	8
1		9
2		10

Sunday, Jun. 15

Don't Forget

Father's Day  
166/199

7		3
8		4
9		5
10		6
11		7
12		8
1		9
2		10

**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**

Applicant(s): Locher

Docket No.

( R ) S11-US

Serial No.

09/068,278

JUN 13 2003

Filing Date

July 9, 1998

Examiner

Ergenbright

Group Art Unit

3722

Invention:

I hereby certify that this Amendment After Final Action, Notice of Appeal, Petition to Revive

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C.

20231-0001 on June 13, 2003

(Date)

M. Robert Kestenbaum

(Typed or Printed Name of Person Mailing Correspondence)

M. Robert Kestenbaum

(Signature of Person Mailing Correspondence)

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("Express Mail" Mailing Label Number)

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JUN 17 2003

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